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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/685,919	10/15/2003	William E. Welnick	33692.03.3198	7060
23418	7590	08/23/2005	EXAMINER	
VEDDER PRICE KAUFMAN & KAMMHOLZ 222 N. LASALLE STREET CHICAGO, IL 60601			STEIN, JULIE E	
			ART UNIT	PAPER NUMBER
			2685	

DATE MAILED: 08/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/685,919

Applicant(s)

WELNICK ET AL.

Examiner

Julie E. Stein, Esq.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-12 and 14-20 is/are rejected.
- 7) ☐ Claim(s) 13 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Claim Objections

1. Claim 13 is objected to because of the following informalities: in the last line, "that includes" does not appear to be necessary. Appropriate correction is required.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

4. In claims 1-8, the use of "operative to" and then "perform", "attempt", "acquisition", or "receive" does not recite an action, the claims merely recite a possibility, thereby rendering the claims indefinite.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-4, 6-7, 8-12, and 14-20 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,734,980 to Hooper et al.

Hooper discloses all the elements of claim 1, including a circuit (inherent in view of the steps of Figure 2) operative to acquire a more-preferred stored SID element

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comprising: memory containing a roaming list that includes a plurality of stored SID elements ranked according to an order of preference (column 6, lines 41 to 65) including at least one more-preferred stored SID element and at least one less-preferred stored SID element (Id.); and logic circuitry, operatively coupled to the memory (inherent in view of the steps of Figure 2), and operative to perform a first more-preferred SID acquisition sequence (Figure 2 and column 7, line 39 to column 9, line 45) and then a second more-preferred SID acquisition sequence (column 9, line 46 to column 10, line 65) that includes repeatedly attempting acquisition of the at least one more-preferred stored SID element during the second more-preferred SID acquisition sequence (Id., this occurs during the repeated search of frequencies, which is being interpreted to all be part of the second more-preferred SID acquisition sequence).

The rejection of claim 1 is hereby incorporated. Hooper discloses all the elements of claim 6, including a wireless device comprising: memory containing a roaming list that includes a plurality of stored SID elements ranked according to an order of preference (column 6, lines 41 to 65) including at least one more-preferred stored SID element and at least one less-preferred stored SID element (Id.); a wireless receiver operative to receive transmitted SID information (inherent in view of column 6, lines 41 to 65 and the receiving of SIDs); and logic circuitry, operatively coupled to the memory (inherent in view of the steps of Figure 2), and operative to perform a first more-preferred SID acquisition sequence (Figure 2 and column 7, line 39 to column 9, line 45) and then a second more-preferred SID acquisition sequence (column 9, line 46 to column 10, line 65) that includes repeatedly attempting acquisition of the at least one

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more-preferred stored SID element during the second more-preferred SID acquisition sequence (Id.).

The rejections of claims 1 and 6 are hereby incorporated. Hooper discloses all the elements of claim 8, including a wireless device comprising: memory containing a roaming list that includes a plurality of stored SID elements ranked according to an order of preference (column 6, lines 41 to 65) including at least one more-preferred stored SID element and at least one less-preferred stored SID element (Id.); a wireless receiver operative to receive transmitted SID information (inherent in view of column 6, lines 41 to 65 and the receiving of SIDs); and logic circuitry, operatively coupled to the memory (inherent in view of the steps of Figure 2), and operative to perform a first more-preferred SID acquisition sequence (Figure 2 and column 7, line 39 to column 9, line 45) and then a second more-preferred SID acquisition sequence (column 9, line 46 to column 10, line 65) that includes, during the second more-preferred SID acquisition sequence, repeatedly attempting acquisition of the at least one more-preferred stored SID element and a single acquisition attempt of each of the plurality of less-preferred stored SID elements not acquired during the first more-preferred SID acquisition sequence (column 9, line 60 to column 10 line 64), wherein attempting acquisition is based on a comparison of the received broadcast SID information with one of the plurality of stored SID elements (column 9, lines 1 to 11), and wherein the second more-preferred SID acquisition sequence is again performed if acquisition of the plurality of stored SID elements in the roaming list is unavailable (column 10, line 65 to column 11, line 13).

The rejections of claims 1, 6, and 8 are hereby incorporated. Hooper discloses all the elements of claim 10, including a memory containing instructions executable by one or more processing devices that causes the one or more processing devices (see above) to: store a roaming list that includes a plurality of stored SID elements ranked according to an order of preference (see above) including at least one more-preferred stored SID element and at least one less-preferred stored SID element (see above); and perform a first more-preferred SID acquisition sequence and then a second more-preferred SID acquisition sequence that includes repeatedly attempting acquisition of the at least one more-preferred stored SID element during the second more-preferred SID acquisition sequence (see above).

The rejections of claim 1, 6, 8, and 10 are hereby incorporated. Hooper discloses all the steps of claim 14, including a method for acquiring a more-preferred stored SID element in a wireless device (see above), the method comprising: storing a roaming list that includes a plurality of stored SID elements ranked according to an order of preference (see above) including at least one more-preferred stored SID element and at least one less-preferred stored SID element (see above); and performing a first more-preferred SID acquisition sequence and then a second more-preferred SID acquisition sequence that includes repeatedly attempting acquisition of the at least one more-preferred stored SID element during the second more-preferred SID acquisition sequence (see above).

The rejections of claim 1, 6, 8, 10 and 14 are hereby incorporated. Hooper discloses all the steps of claim 19, including a method for acquiring a more-preferred

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stored SID element in a wireless device (see above), the method comprising: storing a roaming list that includes a plurality of stored SID elements ranked according to an order of preference (see above) including at least one more-preferred stored SID element and a plurality of less-preferred stored SID elements (see above); performing a first more-preferred SID acquisition sequence and then a second more-preferred SID acquisition sequence that includes, during the second more-preferred SID acquisition sequence, repeatedly attempting acquisition of the at least one more-preferred stored SID elements not acquired during the first more-preferred SID acquisition sequence (see above); receiving broadcast SID information wherein attempting acquisition is performed by comparing the received broadcast SID information with one of the plurality of stored SID elements (column 9, lines 1 to 11); and repeatedly performing the second more-preferred SID acquisition sequence if acquisition of the plurality of stored SID elements in the roaming list is unavailable (column 10, line 65 to column 11, line 13).

Hooper also discloses all the elements of claims 2, 7, and 11, including wherein the logic circuitry is operative to attempt acquisition of the at least one less-preferred stored SID element as part of performing the second more-preferred SID acquisition sequence. See, column 9, lines 12 to 28.

Hooper also discloses all the elements/steps of claims 3, 12, and 17, including wherein the logic circuitry is operative to perform the second more-preferred SID acquisition sequence if the more-preferred stored SID element is not acquired during the first more-preferred SID acquisition sequence. See, column 10, line 65 to column 11, line 13.

Hooper also discloses all the elements of claim 4, including, wherein the logic circuitry is operative to attempt acquisition by comparing by received broadcast SID information with one of the plurality of stored SID elements. See, column 9, lines 1 to 11.

Hooper also discloses all the elements of claim 9, including the logic circuitry camps on at least one less-preferred stored SID element if acquisition on the at least one less-preferred stored SID element is available (column 10, lines 47 to 64) and if acquisition on the at least one more-preferred store SID element is unavailable (Id.), and wherein the logic circuitry camps on the at least one more-preferred SID stored element if the at least one more-preferred stored SID element is acquired at any time (column 10, line 65 to column 11 line 13).

Hooper also discloses all the steps of claim 18, including attempting acquisition of the at least one less-preferred stored SID element as part of performing the second more-preferred SID acquisition sequence. See, column 9, lines 12 to 28.

Hooper also discloses all the elements of claim 20, including camping on the at least one more-preferred stored SID element if acquisition of the at least one more-preferred stored SID element is available (column 9, lines 1 to 11); and camping on the at least one less-preferred stored SID element if acquisition of the at least one less-preferred stored SID element is available and if acquisition of the at least one more-preferred stored SID element is unavailable (column 10, lines 47 to 64).

Hooper also discloses all the elements of claim 16. See the rejection of claims 9 and 20.

Allowable Subject Matter

7. Claim 13 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

8. Claim 5 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

9. The following is a statement of reasons for the indication of allowable subject matter: with regards to claims 5 and 13, the prior art of record does not teach or suggest a second acquisition sequence in which repeated acquisition attempts are performed for both a first and second most preferred SID and a single acquisition attempt for each of the rest of the less preferred stored SID elements.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. U.S. Patent Nos. 6,584,311 to Sorenson et al. teaches a method of scanning for optimal service acquisition; 5,870,674 to English teaches a method for selecting a communication system; and 5,784,693 to Barber et al. teaches a method of selecting a cellular carrier.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Julie E. Stein, Esq. whose telephone number is (571) 272-7897. The examiner can normally be reached on M-F (8:30 am-5:00 pm).

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Urban can be reached on (571) 272-7899. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JES

Nguyen Vo
8/16/2005

NGUYEN T. VO
PRIMARY EXAMINER